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OFFICE OF PETITIONS

In re Application of :
Ryu, et al. :
Application No. 09/882,043 : **DECISION**
Filed: 18 June, 2001 :
Attorney Docket No. AB-1604 US :

This is a decision on the petitions filed on 27 July, 2005, and properly considered as a petition requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

The petition under 37 C.F.R. §1.181 is **DISMISSED**.

Any request for reconsideration of this decision should be filed **within two (2) months** from the mail date of this decision. *Note* 37 C.F.R. §1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 C.F.R. §1.181 to Withdraw the Holding of Abandonment."

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

As to the Request to Withdraw
the Holding of Abandonment

Petitioner is directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness and showing requirements for relief under 37 C.F.R. §1.181.

Petitioner appears not to comply with the guidance in the Commentary at MPEP §711.03(c)(I)—as discussed below, Petitioner has failed to satisfy the showing requirements set forth there. Petitioner may find it beneficial to review that material and move step-wise through that

guidance in the effort to satisfy the showing requirements (statements and supporting documentation).

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to a final Office action mailed on 18 May, 2004, with reply due absent extension of time on or before 18 August, 2004.

On 13 August, 2004, Petitioner (former Counsel) filed *inter alia*, an after-final amendment, which Petitioner as one registered to practice before the Office is aware is not of right and was not a proper reply,¹ and the Examiner mailed an Advisory Action on 16 September, 2004.

On 17 November, 2004, Petitioner filed a request and fee for extension of time and a Notice of Appeal and fee.

On 14 January, 2005, Petitioner filed a request for continued examination (RCE) with fee and a submission under 37 C.F.R. §1.114 in the form of an information disclosure statement (IDS), however, the RCE was an improper RCE because Petitioner failed to satisfy the reply requirements of under 37 C.F.R. §1.114 in that the submission in reply to an Office action after final, after an *ex parte Quayle* action, or after Notice of Appeal must satisfy the requirements of 37 C.F.R. §1.111. (See: MPEP §706.07(h)(II))

The application went abandoned by operation of law after midnight 18 January, 2005.

The Office mailed a Notice of Abandonment on 28 June, 2005.

On 27 July, 2005, Petitioner filed a petition and averred non-receipt of a Notice of Improper RCE, however, Petitioner—as one registered to practice before the Office—is aware that such Notice is not required in that the triggering event (as discussed above) was Petitioner's failure to reply timely and properly to the final Office action mailed on 18 May, 2004.

Thus, Petitioner failed to support the petition properly consistent with the express requirements set forth in the Commentary at MPEP §711.03(c)(I)—to which Petitioner's attention always is drawn in these matters.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of

¹ A proper reply is an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission under 37 C.F.R. §1.114). (See: MPEP §711.03(c).)

representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Allegations as to the Request to
Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner failed to make the showing required.

CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.181 is **dismissed**.

ALTERNATIVE VENUE

Should Petitioner wish to revive the application, Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, a terminal disclaimer and fee where appropriate and a statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.” (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner’s duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

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 Attn: Office of Petitions

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.